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IN THE

Supreme Court of the United States

No. 123.

October Term, 1948.

CARTER CARBURETOR CORPORATION,
Petitioner,

v.

LAWRENCE C. KINGSLAND, Commissioner of Patents,
Respondent.

REPLY TO BRIEF FOR RESPONDENT.

HUGH M. MORRIS,
GILBERT P. RITTER,
Attorneys for Petitioner.

GEORGE R. ERICSON,
Of Counsel.

International, 236 Chestnut St., Phila. 6, Pa.

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REPLY TO BRIEF FOR RESPONDENT.

To the Honorable the Chief Justice of the United States and the Associate Justices of the Supreme Court of the United States:

Petitioner's brief contains two points (pp. 14, 18). They are the "Reasons Relied on for Allowance of the Writ."

Respondent nowhere attempts to deny or even question the accuracy of any statement made in Petitioner's first "Reason Relied on for the Allowance of the Writ" (Br. of Pet'r., p. 10).

Respondent does not deny that the decision of the Court below relating to the construction of RS § 481, as amended [1] (35 USC § 6) and its application to and effect upon RS

[1] "Section 481. The Commissioner of Patents, under the direction of the Secretary of Commerce, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines, and other things belonging to the Patent Office."

§ 483, as amended[2] (35 USC § 6)[3] very extensively and very seriously limits and curtails the rule-making power exercisable under RS § 483 and the "supervision" of the Patent Office by the Secretary of Commerce;[4] wholly disregards the effect of the provision of RS § 481 that the authority conferred upon the Commissioner by that section is to be exercised "under the direction of the Secretary of Commerce"; disregards the fact that the Secretary of Commerce gives direction under RS § 481 by regulations established under RS § 483 by the Commissioner of Patents with "the approval of the Secretary of Commerce"; disregards the fact that RS § 481 may not be construed without reference to the words "under the direction of the Secretary of Commerce" embodied in that section or without regard to RS § 483 and the regulations established thereunder by the Commissioner of Patents subject to "the approval of the Secretary of Commerce." Respondent's brief does not deny that the decision of the Court below nullifies many of the present regulations made pursuant to RS § 483 with the

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[2] "Section 483. The Commissioner of Patents, subject to the approval of the Secretary of Commerce, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office."

[3] 35 USC "§ 6. Duties of commissioner. The Commissioner of Patents, under the direction of the Secretary of Commerce, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines, and other things belonging to the Patent Office. He may, subject to the approval of the Secretary of Commerce, from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office. R. S. §§ 481, 483; Feb. 14, 1903, c. 552, § 12, 32 Stat. 830."

[4] Executive order of March 17, 1925 published in Official Gazette of March 31, 1925, Vol. 332, p. 957, which transferred the Patent Office and its "supervision" from the Department of the Interior (RS § 441; 5 USC § 485) to the Department of Commerce.

approval of the Secretary of Commerce. It does not deny that the decision of the Court below confers upon the Commissioner jurisdiction, power and authority to perform, under the guise of supervisory authority, acts of a judicial or quasi-judicial character, jurisdiction to perform which has been expressly confided by Rule or Statute to other Patent Office tribunals.

In its brief, Respondent does not deny that the questions decided by the Court below have not been, but should be, settled by this Court.

On the contrary, Respondent in its brief attempts to dwarf the importance of the questions decided by the Court of Appeals and to belittle and minimize the effect of the order of the Commissioner dated July 19, 1946 by repeatedly contending that the only effect of that order is to fix "the order of taking testimony" in the interference.

But the challenged order (R. 34) of the Commissioner is a complete refutation of the contention of Respondent that the only effect of that order is to fix "the order of taking testimony" in the interference. The challenged order of the Commissioner reveals that its reach extends far beyond the limits suggested by Respondent. It gives evidential value, as against Petitioner, to a judgment of the District Court for the District of Columbia to which neither Petitioner nor its assignor was a party or privy. That challenged order holds that the Patent Office "will accept the Court's decision as correct, unless it is shown [by Petitioner] not to be so." It thus imposes the will of the Commissioner upon the Board of Interference Examiners contrary to the provisions of the Acts of the Congress of March 2, 1927 and August 5, 1939. It imposes upon Petitioner the burden of proving the negatives that the joinder as inventors of Hunt and Olson in their joint application was *not* a mistake, that that application was *not* filed in good faith, and that reasonable diligence was *not* exercised to correct any mistake, if such there was, in filing that joint appli-

cation—all of which are matters peculiarly within the knowledge of Hunt and Olson.

That challenged order deprives Petitioner of the benefit of the presumption of priority of invention to which he is entitled under the very terms of Patent Office Rule 116.[5]

Instead of challenging the soundness and substantial character of the "Reasons Relied on for Allowance of the Writ," which Petitioner understands are the only matters now for consideration (Rule 38, 4 (c)), Respondent's brief seems to be devoted mainly, if not entirely, to an attempt to persuade this Court that the decision of the Court of Appeals is correct and, for that reason, that there is no warrant for issuing the Writ. The decision of the Court below is founded on the novel doctrine that the Patent Office Rules are not binding upon the Commissioner because the duty of superintendence conferred upon him by R. S. § 481 is supreme, and therefore relieves the Commissioner from the binding effect of those rules. The decision of the Court below is in effect that if the Commissioner asserts that any act of his is done under "the supervisory authority of the Commissioner," the Rules of the Patent Office established under R. S. § 483 with the approval of the Secretary of Commerce, though purporting to pertain to and govern such act, are without relevance or significance, even in the absence of any showing that the Secretary of Commerce has

[5] "116. The parties to an interference will be presumed to have made their inventions in the chronological order in which they filed their completed applications for patents clearly disclosing the same; and the burden of proof will rest upon the party who shall seek to establish a different state of facts.

The termination of the interference by dissolution under rule 122 without an award of priority shall not disturb this presumption, and a party enjoying the status of a senior party with respect to any subject-matter of his application shall not be deprived of any claim to such subject-matter solely on the ground that such claim was not added to the interference by amendment under rule 109."

given to the Commissioner any direction (R. S. § 481), save by the rules, with respect to the challenged act of the Commissioner. That decision by the Court of Appeals seems clearly to overlook or disregard the express limitation of R. S. § 481; the interrelation of R. S. § 481, R. S. § 483 and the regulations established thereunder, and the conflicting declaration of this Court in *Ewing v. Fowler Car Co.*, 244 U. S. 1, 3-4, that

> "regulations known as 'Rules of Practice in the United States Patent Office' * * * have the force and effect of law binding as well upon the Commissioner as upon the applicant for patents."

By the decision of the Court of Appeals, power, unrestrained save by his will, would seem to be conferred upon the Commissioner with respect to all patent office matters. Such a consequence is a matter of the utmost importance to all members of the public having business with the patent office. Indeed, that decision would seem to violate the fundamental principle that compliance by government officials with departmental rules is essential to due process of law guaranteed by the Constitution of the United States (R. 25).

The fundamental and basic character of the questions presented to this Court is clearly revealed by the antithetically divergent views of the two Courts below (R. 22-25 and R. 119-121) with respect to the jurisdiction and powers of the Commissioner of Patents, the rights of the public under the statutes here involved and the regulations established under RS § 483 with the approval of the Secretary of Commerce. Until those basic questions are decided by this Court, the orderly conduct of procedure in the Patent Office in conformity with regulations established pursuant to RS § 483 will undoubtedly be supplanted by other decisions of the Commissioner inconsistent with the statutes and Rules of the Patent Office hitherto deemed to be binding upon it; and the rights of the public having business relations with

the Patent Office will undoubtedly be governed not by established procedure as contemplated by RS § 483 but will depend and turn upon the unrestrained will of the Commissioner.

* * *

In the conclusion to his brief (pp. 15-16) Respondent says:

> "* * * there is no conflict with any applicable decision of this Court. * * *"

Petitioner submits that in that statement Respondent is wholly in error. Petitioner submits that *Ewing v. Fowler Car Co.*, 244 U. S. 1, 3-4, and *Butterworth v. Hoe*, 112 U. S. 50, are both here most pertinent, applicable, and in conflict with the decision of the Court below. The former of those cases holds that the Rules of Practice in the United States Patent Office have the force and effect of law binding as well upon the Commissioner as upon the applicant for patents.

Indeed, Respondent concedes (his Br. p. 11) that

> "* * * the Rules of Practice are binding upon the Commissioner (see Ewing v. Fowler Car Co., 244 U. S. 1, 3-4), * * *"

But Respondent contends (his Br. p. 11) and the Court below held (R. 121) that

> "The Patent Office Rules not only do not, but could not, limit the Commissioner's supervisory authority."

In so contending and holding, Respondent and the Court below wholly overlook, or disregard, the requirement of RS § 481 that the powers and jurisdiction conferred upon the Commissioner by that statute are to be exercised "under the direction of the Secretary of Commerce," and that such direction is put into effect in and by the regulations established under RS § 483 with "the approval of the Secretary of Commerce." In view of those two sections of the

statutes, the Patent Office Rules are limitations of the Commissioner's powers under RS § 481 and deny to the Commissioner jurisdiction, power, or authority to perform any act in contravention thereof. By overlooking or disregarding that fact, the Court below has extended the jurisdiction of the Commissioner far beyond that authorized by RS § 481 when construed in the light of RS § 483.

Petitioner further submits that the decision of the Court below is in conflict with the principle of the decision of this Court in *Butterworth v. Hoe*, 112 U. S. 50. Respondent here takes the position (his Br. p. 10) that the Commissioner's

> "• • • duty of supervision extends to *all*[6] activities of lower Patent Office tribunals respecting the granting and issuing of patents and extends to rulings made by these tribunals in interference proceedings. • • •"

In the *Hoe* case, the Secretary of the Interior claimed that his powers of supervision and direction extended

> "to all the official acts of the Commissioner, without regard to any distinction between those which are merely ministerial and those which are judicial in their nature; and that such supervision and direction may be exerted at any stage of a proceeding, in the discretion of the Secretary, whether in advance, or during its progress, or after its termination, and embraces, therefore, the mode of appeal, though no appeal, in express terms, is actually given." (112 U. S. 55)

This Court there denied the soundness of that contention for reasons that seem equally applicable in the case at bar.

Respondent's contention that the *Hoe* case is here inapplicable is made to rest in whole or in part (his Br. footnote 4, p. 14) upon the ground that

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[6] Emphasis is Petitioner's.

> "• • • the statute there involved merely stated that the Commissioner was to act under the direction of the Secretary; • • •."

Again, Petitioner must submit that Respondent is wholly in error. RS § 441 was among the statutes there involved and relied upon by the Secretary of the Interior. It provided:

> "The Secretary of the Interior is charged with the supervision of public business relating to the following subjects; • • • FIFTH: Patents For Inventions. • • •"

It was under that statute—manifestly less restricted than RS § 481 which subjects the Commissioner to the direction of the Secretary of Commerce—as well as under RS §§ 481 and 483, that the Secretary of the Interior made his aforesaid claim in the *Hoe* case.

Petitioner submits that the "Reasons Relied on for Allowance of the Writ" stand wholly unrefuted by the Brief of Respondent; that the Court below decided questions of substance relating to the construction of Federal Statutes gravely affecting the public in the patent field without giving effect to the decisions of this Court in *Butterworth v. Hoe*, 112 U. S. 50 and *Ewing v. Fowler Car Co.*, 244 U. S. 1, 3-4.

CONCLUSION.

WHEREFORE, Petitioner earnestly prays that the petition for writ of certiorari be granted, the cause reviewed and the decree of the United States Court of Appeals for the District of Columbia be reversed.

Respectfully submitted,

HUGH M. MORRIS,
GILBERT P. RITTER,
Attorneys for Petitioner.

GEORGE R. ERICSON,
Of Counsel.

Dated: August 17, 1948.